UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte TONY M. POKORZYNSKI
and
TIMOTHY J. THEISEN

Appeal No. 2003-1176
Application No. 09/074,288

ON BRIEF

Before WARREN, DELMENDO, and GAUDETTE, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON REHEARING

This is a decision on a request for rehearing (hereinafter "request") pursuant to 37 CFR § 197(b)(2003)(effective December 1, 1997),[1] filed on November 10, 2003, of our September 10, 2003 decision. Ex parte Pokorzynski, Appeal No. 2003-1176 (Bd. Pat. App. & Int., September 10, 2003)(hereinafter "original

[1] 37 CFR § 1.197(b) has since been rewritten as 41.52(a)(i)(2005)(effective September 13, 2004).

decision").[2]

We have reconsidered our original decision in light of the appellants' arguments in the request. For the reasons stated below, we are not persuaded that we misapprehended or overlooked any point made in the appellants' briefs[3] to justify a different outcome in this appeal. Accordingly, the appellants' request for a modification of our original decision is denied.

Background

Representative appealed claims 1 and 2 read as follows:

> 1. An integrated interior trim member for a vehicle comprising:
> a porous substrate;
> an upholstery skin material, said upholstery skin material being substantially coextensive with said substrate; and
> a molded foam material extending between said upholstery skin material and said substrate, said

[2] For reasons not entirely clear to us, the appellants' request for rehearing was not received by the Board of Patent Appeals and Interferences until of May 2, 2006. We note that the electronic record of this application reveals that the United States Patent and Trademark Office erroneously issued a notice of abandonment on November 25, 2003. Upon learning of the erroneous holding of abandonment through the "PAIR" system, the appellants filed a petition under 37 CFR § 1.181 on June 18, 2004. In a decision mailed on November 30, 2005, the Director of Technology Center 1700 granted the appellants' petition to withdraw the holding of abandonment.

[3] See appeal brief filed on November 15, 2002 and reply brief filed on April 1, 2003.

> molded foam material bonding said skin material to said porous substrate, whereby said porous substrate is held to a backside of the trim member that is opposite of the upholstery skin material.
>
> 2. The interior trim piece as defined in Claim 1, wherein said substrate comprises a porous fiberous [sic] material having openings therein, wherein said moldable foam material penetrates said openings and bonds to said porous material through said openings.

In our original decision, we affirmed the examiner's decision to reject the claims on all three grounds. (Original decision at 3.) Specifically, we affirmed the examiner's rejections under:

A. 35 U.S.C. § 102(b) of appealed claims 1 through 4 and 6 through 10 as anticipated by United States patent 5,082,609 issued to Rohrlach et al. (Rohrlach) on January 21, 1992;

B. 35 U.S.C. § 102(b) of appealed claims 1 through 4 and 6 through 10 as anticipated by United States patent 5,180,617 issued to Takeuchi et al. (Takeuchi) on January 19, 1993; and

C. 35 U.S.C. § 103(a) of appealed claims 1 through 4 and 6 through 10 as unpatentable over Takeuchi.

With respect to Rohrlach, we found (original decision at 5):

> Rohrlach describes a molded panel (e.g., a vehicle door inner panel) constructed of a substrate 11 of a continuous filament glass reinforcement penetrated by a crosslinked rigid polyurethane, which overlies a partly cellular (i.e., foamy) high density lamina 12 of polyurethane, which in turn is adhered to a finish face 13. (Figure 1a and 1b; column 1, lines 4-8 and 37-55; column 2, line 44 to column 3, line 20.) According to Rohrlach, the crosslinked rigid polyurethane that penetrates or embodies the filament glass substrate 13 [sic, 11] is a foam material. (Column 1, lines 36-49.)

We further determined that "Rohrlach's rigid foam material penetrating or embodying the filament glass substrate 11 bonds (1) the partly cellular high density lamina 12/finish face 13 structure, which corresponds to the here recited 'upholstery skin material,' to (2) the substrate 11, which corresponds to the here recited 'porous substrate.'" (Original decision at 5.) While the appellants argued that Rohrlach does not describe a porous substrate as part of the claimed trim member (appeal brief at 6; reply brief at 1), we were not persuaded by this argument because the written description of the appellants' specification (e.g., page 9, lines 7-15; Figure 7) informed one skilled in the relevant art that structures such as those described in Rohrlach are encompassed by the appealed claims. (Original decision at 6-7.) Accordingly, we held that Rohrlach describes, within the meaning of 35 U.S.C. § 102(b), every

limitation of the invention recited in the appealed claims. (Id. at 5-6 and 8.)

With respect to the rejections based on Takeuchi, we determined (original decision at 8):

> Takeuchi describes a vehicle door trim A comprising, inter alia, a mat-shaped glass fiber reinforcing material 1 within a foam base material 3 that is molded integrally on the back side of a facing material 5. (Column 3, lines 23-31; Figures 1-3.) Takeuchi, therefore, describes every limitation of the invention recited in appealed claims 1 and 2.[4]

The appellants argued that Takeuchi's mat-shaped fiber reinforcing material is not porous after impregnation with the foam base material 3 (appeal brief at 10), but we found this contention without merit for the same reasons discussed above with respect to Rohrlach. (Original decision at 9.)

Discussion

In their request, the appellants urge (request at 1):

> The Board of Patent Appeals and Interferences did not understand that the prior art does not teach or suggest an article meeting all of the requirements of the claims at a single moment in time. Neither of the applied prior art references teaches or suggests an article that simultaneously has a porous substrate and

[4] As to obviousness, we cited precedents holding that a prior art disclosure that anticipates a claim under 35 U.S.C. § 102 also renders the claim obvious under 35 U.S.C. § 103(a). (Original decision at 9.)

> an upholstery skin that is bonded to the porous substrate, as is required by the claims. While the prior art teaches an article that is prepared using a porous material, and includes an upholstery layer, it is not until after the originally porous material has become completely impregnated by a resin composition and has lost its porous character that the upholstery becomes bonded to the resulting non-porous substrate. Thus, while the prior art teaches the individual elements of the claims, it does not teach or suggest the claimed combination. [Emphases original.]

Again, we find no merit in the appellants' position. The dispositive issue in this appeal seems to be whether appealed claim 1 excludes the existence of a foam material within the pores of the substrate (e.g., "porous fiberous [sic] material having openings therein, wherein said moldable foam material penetrates said openings and bonds to said porous material through said openings" as recited in appealed claim 2). As explained in our original decision, appealed claim 1 does not exclude the existence of a foam material within the openings or pores of the substrate material.

The porous nature of the glass fiber reinforcing materials (i.e., substrate) described in the references never changes, even after they are combined with a foam material to form the final product. That is, even assuming that the openings or pores are completely filled with resin material, the prior art glass fiber reinforcing materials per se (as distinguished from

the non-porous combination of the glass fiber reinforcing materials and the resin) are still porous. The appealed claims, in particular claim 2, read on such prior art structures. Nothing in the language of the appealed claims excludes the presence of resin in all of the spaces constituting the openings or pores of the substrate. For example, appealed claim 1 does not recite language such as "wherein the molded foam material does not occupy all of the openings or pores of the substrate." To the contrary, appealed claim 2 broadly recites: "wherein said substrate comprises a porous fiberous [sic] material having openings therein, wherein said moldable foam material penetrates said openings and bonds to said porous material through said openings." In re Morris, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997)("It is the applicants' burden to precisely define the invention, not the PTO's.").

Also, the subject specification severely undercuts the appellants' position. There, the appellants repeatedly disclose that the claimed invention includes embodiments where resin advantageously penetrates the openings or pores of the substrate. (Specification at page 2, lines 10-12; page 5, lines 8-11; page 7, lines 5-7; page 8, line 9 to page 9, line 15; Figure 7.) Were we to accept the appellants' arguments, our

claim construction would be contrary to the enlightenment found in the specification. This we cannot do. In re Morris, 127 F.3d at 1054, 44 USPQ2d at 1027 ("[I]t would be unreasonable for the PTO to ignore any interpretive guidance afforded by the applicant's written description...").

Finally, the appellants argue: "Rohrlach only teaches a porous substrate that is completely penetrated by a liquid (non-foam) resin (column 2, lines 44-50)..." (Request at 2.) This argument is incorrect. According to Rohrlach, the crosslinked rigid polyurethane that penetrates or embodies the filament glass substrate 11 is a foam material. (Column 1, lines 36-49.)

Summary

In sum, the appellants' request for rehearing is granted to the extent of reconsidering our original decision but is denied with respect to making any substantive changes thereto.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

DENIED

Charles F. Warren)
Administrative Patent Judge)
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Romulo H. Delmendo) BOARD OF PATENT
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